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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|-----------------|-------------|----------------------|----------------------|------------------|
| 09/605,799      | 06/28/2000  | Oleg B. Rashkovskiy  | INTL-0413-US (P8908) | 6037             |

7590

09/08/2005

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EXAMINER

ONUAKU, CHRISTOPHER O

ART UNIT

PAPER NUMBER

2616

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                       |   |  |
|------------------------------|---------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/605,799  | <b>Applicant(s)</b><br>RASHKOVSKIY ET AL. |  |
|                              | <b>Examiner</b><br>Christopher Onuaku | <b>Art Unit</b><br>2616                   |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-9,11-17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-9,11-17,19&20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 3/17/05 have been fully considered but they are not persuasive.

Applicant argues that Alexander merely shows an advertisement for a season premiere episode, that a programming recorder may be set to record at a particular time, but that Alexander does not disclose automatically recording a season series in response to selection of one or more of a plurality of displayed upcoming season premiere episodes.

In response, Alexander clearly discloses wherein a user may highlight ads resulting in the automatic display of an expanded information box. As shown in Fig10A&10B, graphic representations of sample on screen EPG displays depicting one embodiment of the feature of presenting additional information concerning the subject matter of a highlighted Panel AD Window. For example, if a Panel ad has show information, e.g., SEASON PREMIERE episode of the program 60MINUTES, associated with it, the show may be recorded by highlighting the ad and pressing the Right Action button. If the show is on now, recording begins immediately and the show is placed in the Record/Watch Schedule for the duration of the show to allow the user to set the frequency to daily or weekly. If the show is on in the future, that show is added to the Record/Watch Schedule for auto-recording. Shows added to the Record/Watch

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Schedule may be set to be recorded: once, daily, or weekly (see col.21, lines 15-25 and col.21, lines 39-67).

From the above discussion, it can be seen that the user uses a graphical user interface as shown in Fig.10B to display information on the SEASON PREMIERE episode of the program 60MINUTES, for example, which the user may program the system of Alexander to record if the show is on, or if the show is not on now, the user may select to program the system of Alexander to, for example, record the weekly series of the show 60MINUTES weekly.

Furthermore, applicant argues that the combination of Alexander and Naimpally is improper because the Office Action does not provide motivation from the cited references to support the proposed combination.

In response, it is pertinent to point out that it is not necessary that the references actually suggest, expressly or in so many words, the changes or improvements that applicant has made. The test for combining references is what the references as a whole would have suggested to one of ordinary skill in the art. In re Sheckler, 168 USPQ 716 (CCPA 1971); In re McLaughlin, 170 USPQ 209 (CCPA 1971); In re Young, 159 USPQ 725 (CCPA 1969).

Moreover, the test for obviousness is not whether the features of the reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the references make obvious to one of ordinary skill in the art. In re Bozek, 163 USPQ 545 (CCPA 1969); In re Richman, 165 USPQ 509, (CCPA 1970); In re Beckum, 169 USPQ 47 (CCPA 1971); In re Sneed, 710 F.2d 1544, 218 USPQ 385.

The desirable advantage of modifying the Alexander system to automatically acquire a schedule for the season series over the internet, as taught by Naimpally, is enough motivation to combine Alexander and Naimpally.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,2,4-6, 8,9,11-13,15-17,19&20 are rejected under 35 U.S.C. 102(e) as being anticipated by Alexander et al (US 6,177,931).

Regarding claims 1 , 8, and 15, Alexander et al discloses providing a graphical user interface (GUI) indicating a season premiere episode corresponding to a plurality of upcoming season series of a television programs (see Fig. 10A and the information on the SEASON PREMIER showing of the program “TOOL TIME” shown by ABC; and Fig.10B and the information on the SEASON PREMIER showing of the program “60 MINUTES” shown by CBS); and in response to the selection of one or more season premier episodes through the interface (fig 10 A and 10B), automatically recording the season series (see col.21, lines 15-25 and col.21 , lines 39-67). Here, as disclosed by Alexander et al, the viewer can select to record the season series (of 60 MINUTES, for

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example) starting currently by pressing the "Record" button or at a future time once, daily or weekly by pressing the Left Action button which places the show in the Record/Watch Schedule

Regarding claims 2, 9, and 16, Alexander et al discloses providing an electronic program guide (EPG, fig. 1).

Regarding claims 5 and 12, Alexander et al discloses storing information about the season series in a database (col. 18, lines 1-12).

Regarding claims 6, 13, and 20, Alexander et al discloses acquiring information about the season series over the internet (col. 8, lines 1-12).

Regarding claim 17, Alexander et al discloses an interface coupled to the processor for wireless communications (col. 4, lines 20-45), the system further including a remote control unit that communicates with the interface (col. 3, lines 21-35).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7&14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander et al in view of Naimpally (US 6,020,880).

Regarding claims 7 and 14, Alexander et al does not disclose automatically acquiring a schedule for the season series over the internet. Naimpally teaches acquiring program data over the internet. Alexander et al discloses automatically tuning or recording a season series, as discussed previously. To perform the automatic tuning or recording the scheduling data of the series is needed.

It would have been highly desirable to have scheduling data acquired over the internet so that the automatic tuning or recording function could identify times that another program in the series is to be recorded or watched.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the season series information acquired over the internet in the device of Alexander et al.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Onuaku whose telephone number is 571-272-7379. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. NOTE: Effective July 15, 2005, the Central Fax Number will change to 571-273-8300. Faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should



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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
COO

8/23/05

  
James J. Groody  
Supervisory Patent Examiner  
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